



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **TAUBER et. al**

Application Serial No.: **10/801,166**

5 Application Filed: **March 11, 2004**

Attorney Docket No.: **CECOM 5521**

For: **RARE EARTH METAL COMPOUNDS FOR USE IN HIGH CRITICAL
TEMPERATURE THIN FILM SUPER-CONDUCTORS**

10 Sir:

These Remarks are submitted in support of amending the above-identified application.

REMARKS

Claims 45-47 and 80 are now in the case. No new claims have been added.

15 Separate Amendments To The Claims and these Remarks are enclosed with this
Amendment.

This Amendment responds to the first non-final Office Action in the case wherein the
Examiner objected to the lack of proper antecedent basis in the specification for portions of
claims 45 and 47 and informalities in claims 45 and 47. The Examiner also rejected claims 45-
20 47 and 80 under 35 USC § 112, first paragraph, for failing to comply with the written description
requirement by containing new matter. The Office Action also included an Allowable Subject
Matter Statement for claims 45-47 and 80.

Each objection, rejection and response is set forth in more detail below. This
Amendment indicates that the specification already includes proper antecedent basis for the
25 objectionable portions of claims 45 and 47, corrects informalities in claims 45 and 47, points out
that dielectric constants recited in claims 45 and 47 are not prohibited new matter and revises
claim 47 to delete the objectionable phrase "less than" to overcome and obviate the Examiner's
35 USC § 112, first paragraph rejection. It is respectfully requested that the Examiner reconsider
the objections and rejections and that claims 45-47 and 80, as amended, be allowed and pass to
30 issue.

The Examiner's objection to the specification for lacking proper antecedent basis appears

to be related to the 35 USC § 112, first paragraph new matter rejection and they will be discussed together more fully below.

The Examiner also objected to informalities in claim 45, line 2 and claim 47, line 3 for including the ungrammatical terminology “of a compound of having.” Claim 45, line 2 and claim 47, line 3 have been corrected by removing the erroneous second “of” from each claim. By correcting these informalities it is respectfully submitted that the Examiner’s claim objections have been overcome and obviated.

The Examiner’s objection to the specification for lacking proper antecedent basis and the 35 USC § 112, first paragraph rejection are both concerned with three instances of new matter in claims 45 and 47. The Examiner’s objection to the specification for lacking proper antecedent basis states that each limitation of claims 45-47 does not appear to have proper antecedence in the specification. The Examiner’s 35 USC § 112, first paragraph rejection states that claims 45-47 and 80 fail to comply with the written description requirement by containing subject matter not described in the specification, specifically claim 45, line 10 included new matter by reciting “151,” claim 47, line 11 included new matter by reciting “163” and claim 47, line 14 included new matter by reciting “less than.” It is respectfully submitted that two of these instances are not new matter, are adequately supported by the specification and that claim 47, line 14 has been revised and corrected to delete the offending phrase “less than.”

Claim 45, line 10, as amended in the Preliminary Amendment recited the plurality of thin films having a low dielectric constant of “15.1,” not “151.” However, the low dielectric constant of 15.1, as well as many other portions of the amended claim, were underlined by the Word Track-Changes feature which may have partially obscured the decimal point in 15.1. In the present Amendment, the recital of “15.1” in claim 45, line 10 has now been accepted in Track-Changes, which eliminates the underlining, and now the decimal point in 15.1 is now plainly visible. Additionally, the low dielectric constant of 15.1 for a $\text{Sr}_2\text{LuSbO}_6$ thin film is adequately supported by specification TABLE I.

Similarly, claim 47, line 11, as amended in the Preliminary Amendment recited the thin films having a low dielectric constant of “16.3,” not “163,” and the decimal point of the 16.3 low dielectric constant was underlined and obscured by the Word Track-Changes feature so that 16.3

was misread as 163. In the present Amendment, the recital of "16.3" in claim 47, line 11 has now been accepted in Track-Changes, which eliminates the underlining, and now the decimal point of 16.3 is plainly visible. Further, the low dielectric constant of 16.3 for a $\text{Sr}_2\text{LaSbO}_6$ thin film is adequately supported by specification TABLE I.

5 The Examiner correctly pointed out that the claim 47, line 14 phrase "less than" is prohibited new matter that is not adequately supported by the specification, and claim 47, line 14 has now been revised and corrected to delete the offending phrase "less than" from the claim.

10 It is further noted that the Examiner also stated that claims 45-47 and 80 appear allowable over the cited prior art of record. It is respectfully submitted that the Examiner's objection to the specification for lacking proper antecedent basis, objection to claim informalities and the 35 USC § 112, first paragraph rejection have been overcome and obviated by the present Amendment. Therefore, it is respectfully requested that the Examiner reconsider the objections and 35 USC § 112, first paragraph rejection, and that the claims, as amended, be allowed and pass to issue.

15 Should the Examiner require further information, the Examiner is invited to telephone the applicant's attorney at the telephone number listed below.

Respectfully Submitted,

20 24 May 2007

DATE


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